

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. KOCIS

Appeal No. 1998-3364
Application No. 08/347,990

ON BRIEF

Before THOMAS, FLEMING, and GROSS, Administrative Patent Judges.

FLEMING, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 2 through 23, all the claims pending in the present application. Claim 1 has been canceled.

The invention relates to devices with a noncontact sensor

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for use in causing the device to transition from the reduced power consumption mode to full power mode.

Independent claim 7 is reproduced as follows:

7. A hand-held intelligent data entry unit ("IDEU") automatically operable in either a low power consumption mode or an active mode, the hand-held IDEU comprising:

a microcontroller;

a noncontact sensor for detecting the presence of a user's hand within a predefined actuation region of said hand-held IDEU while said hand-held IDEU is operating in said low power mode; and

means responsive to said detection for generating a wake up signal to said microcontroller for causing said hand-held IDEU to operate in said active mode.

The Examiner relies on the following references:

Windsor	5,319,250	Jun. 7, 1994
Fung	5,396,635	Mar. 7,
1995		

(Filed Feb. 12, 1993)

Claims 2 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fung in view of Windsor.¹

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the brief and answer for

¹The rejection of claims 7, 18 and 19 under 35 U.S.C. § 103 as being unpatentable over Cavada has been withdrawn by the Examiner. See page 9 of the Examiner's answer.

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respective details thereof.

OPINION

We will not sustain the rejection of claims 2 through 23 under 35 U.S.C. § 103.

The Examiner has failed to set forth a *prima facie* case. It is the burden of the Examiner to establish why one having ordinary skill in the art would have been led to the claimed invention by the express teachings or suggestions found in the prior art, or by implications contained in such teachings or suggestions. *In re Sernaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). "Additionally, when determining obviousness, the claimed invention should be considered as a whole; there is no legally recognizable 'heart' of the invention." *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995), *cert. denied*, 519 U.S. 822 (1996), *citing W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1548, 220 USPQ 303, 309 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

On pages 4 and 5 of the brief, Appellant argues that the combination of Fung in view of Windsor is improper. In

particular, Appellant argues that the Examiner has not demonstrated any motivation in the art for combining these references, other than simply stating that "it would have been obvious" to have done so. Appellant submits that it would not have been obvious to combine the teachings of Fung, relating to a power conservation apparatus for a computer system, with the teachings of Windsor, relating to a pushless run bar for operating heavy machinery.

On pages 5 and 6 of the brief, Appellant argues that neither of the cited references teaches or suggests a hand-held data entry unit, as clearly recited in independent claims 7, 18 and 23. Appellant points out that the invention disclosed by Fung relates to a computer system, while the invention disclosed by Windsor relates to heavy equipment and machinery. Appellant argues that neither of the references discloses or suggests a hand-held data entry unit.

The Federal Circuit states that "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." **In**

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re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992), **citing In re Gordon**, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). It is further established that "[s]uch a suggestion may come from the nature of the problem to be solved, leading inventors to look to references relating to possible solutions to that problem." **Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.**, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), **citing In re Rinehart**, 531 F.2d 1408, 1054, 189 USPQ 143, 149 (CCPA 1976) (considering the problem to be solved in a determination of obviousness). The Federal Circuit reasons in **Para-Ordnance Mfg.**, 73 F.3d at 1088-89, 37 USPQ2d at 1239-40 that for the determination of obviousness, the court must answer whether one of ordinary skill in the art who sets out to solve the problem and who had before him in his workshop the prior art, would have been reasonably expected to use the solution that is claimed by the Appellants. However, "[o]bviousness may not be established using hindsight or in view of the teachings or suggestions of the invention." **Para-Ordnance Mfg.**, 73 F.3d at 1087, 37 USPQ2d at 1239, **citing W. L. Gore & Assocs.**, 721 F.2d

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at 1551, 1553, 220 USPQ at 311, 312-13. In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. ***In re Dembiczak***, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Upon our review of the references, we fail to find that one of ordinary skill in the art who sets out to solve the problem and who had for him in his workshop the Windsor system and the Fung system would have reasonably expected to modify the Fung computer system into a hand-held data entry unit and then further modify Fung by looking to the Windsor pushless run bar which employs two capacitive sensors for detecting the placement of both operator's hands to obtain the Appellant's invention. In particular, we note that Windsor teaches in column 1, lines 10 through 16, that the Windsor system relates to operator stations having two control devices mounted on a common enclosure which must be actuated by two hands. Windsor further discloses in column 1, lines 18 through 37, that Fig. 1 shows the type of run bar which is to be used with automatic machinery such as mechanical or hydraulic power presses,

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assembly machines, transfer machines, milling machines, broaching or grinding machines, welding machines, or material handling equipment and the like. In column 1, lines 38 through 65, Windsor points out that in order that the machines may be started, it is important that the control system ensures that the operator's hands are placed safely on the position of the run bar. Thus, Windsor is concerned with the safety of workers using heavy equipment. Windsor is not concerned with the problem of attempting to save power for a data entry device.

Fung, on the other hand, is a power conservation system for a computer system powered by a battery. Fung does not contemplate a hand-held data entry device, nor does Fung consider the problem of detecting hands placed on such a data entry device to automatically provide wake up for that device. Instead, Fung teaches in column 2, lines 65 through 68, that the system determines exactly when to enter into a power conservation mode. In column 3, lines 1 through 11, Fung teaches that the software determines inactivity by detecting how many "active" or "idle" function calls an application makes within a given time period. Thus, Fung provides no

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teaching or suggestion for detecting the presence of a user's hand within a predefined actuation region of a hand-held intelligent data entry unit.

In view of the foregoing, we have not sustained the rejection of claims 2 through 23 under 35 U.S.C. § 103. Accordingly, the Examiner's decision is reversed.

REVERSED

JAMES D. THOMAS

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Administrative Patent Judge)	
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